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Supreme Court of the United States

OCTOBER TERM, 1925.

No. 107.

ALEXANDER-MILBURN COMPANY,

Petitioner,

against

DAVIS-BOURNONVILLE COMPANY,

Respondent.

BRIEF

BY

THOMAS EWING

AS AMICUS CURIAE.

FILED BY LEAVE OF THE COURT.

STATES BY C. G. BURGOYNE, INC., 107 LIBERTY STREET, NEW YORK

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IN THE

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ALEXANDER-MILBURN COMPANY,
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No. 107—October Term

BRIEF
of
THOMAS EWING
AS *AMICUS CURIAE.*

This brief is substantially the same as that presented to the Court below, to which reference is made in the opinion. It is presented because the case at bar involves a question of construction of the patent statute which is of large public importance.

The writer of the brief has no relation to either party in the suit, nor any interest in any case which, so far as now seen, would be affected by the decision of the case at bar.

The sections of the Revised Statutes and of the Rules of Practice of the Patent Office referred to herein are found in the appendix of the brief for respondent, to which reference is made. The sections of the Patent

Statutes of 1790 and 1793 and of the British Statute of Monopolies referred to are found in the appendix hereto.

The question discussed herein is whether the earlier in filing date of two patents, which were pending concurrently in the Patent Office, will invalidate the patent of later filing date as to common subject-matter claimed in the patent of later filing date and not claimed in the patent of earlier filing date.

There is sharp division of opinion upon this point.

The instant case, 1 F. R. 2d, 227, C. C. A. 2d Circuit;

Farmers' Handy Wagon Co. vs. *Beaver Co.*, 236 F. R., 731, C. C. A., 7th Circuit;

Lemley vs. *Dobson-Evans Co.*, 243 F. R., 391; C. C. A., 6th Circuit.

It sometimes happens that two patents are granted upon co-pending applications where an interference should have been declared. In such a case, in the absence of other proof, the patent filed later is void because of the patent of earlier filing date respecting common subject-matter.

Sundh Electric Co. vs. *Interboro Rapid Transit Co.*, 198 F. R., 94; C. C. A., 2nd Circuit;

Barnes Sprinkler Co. vs. *Walworth*, 60 F. R., 605;

Drewson vs. *Hartje Mfg. Co.*, 131 F. R., 734.

The case here under discussion differs radically from the Sundh and similar cases; for in the case under discussion the claims do not conflict and the subject-matter which is common to the two patents might be cancelled from the earlier patent without impairing it, as was actually done in one recorded case, viz: *Camp Brothers*

vs. *Portable Wagon Company*, 251 F. R., 603 (607), C. C. A., 7th Circuit.

I.

In undertaking to determine whether the rule of the 6th Circuit or the rule of the 7th and 2d Circuits is the sounder rule, the first point to be noted is that an abandoned application for patent is not an anticipation of a later patent for the same subject-matter.

> *Brown* vs. *Guild* (Cornplanter case), 23 Wall., 181.

In the Cornplanter case the Supreme Court had to deal with an alleged anticipation which they concluded was an abandoned experiment. They held that the filing of an application which was ultimately abandoned was inconsequential. The Court said:

> "It can only have a bearing on the question of prior invention or discovery. If upon the whole of the evidence it appears that the alleged prior invention or discovery was only an experiment and was never perfected or brought into actual use, but was abandoned and never revived by the alleged inventor, the mere fact of having unsuccessfully applied for a patent therefor cannot take the case out of the category of unsuccessful experiments."

This case is not cited in the Lemley opinion. *Bates* vs. *Coe* is dismissed therein with the statement that it considered evidence to sustain the third defense only (R. S., p. 4920). But in the Cornplanter case the Court was not considering a question of pleading.

The effect of this decision (1874) upon the practice in the Patent Office is not clear, though it is said to have

changed the practice of the Office. *Webster* vs. *Sanford*, 1888 C. D. 92, 94. However this may be, the fact is, that since 1884, the Office has made no searches among abandoned applications, of which there are now more than a million. During forty years no Court has challenged this practice. See *Rich-Sampliner Co.* vs. *Ensten*, C. C. A., 6th Circuit, 291 F. R., 1003, 1005.

The Supreme Court, speaking of a different question, in *Bates Refrigerating Company* vs. *Sulzberger*, 157 U. S., 1, said (page 34):

> "If * * * there be reasonable ground for adopting either one of two constructions, this Court, without departing from sound principle, may well adopt the construction which is in harmony with the settled practice of the executive branch of the Government, and with the course of judicial decision in the Circuit Courts of the United States; especially, if there be reason to suppose that vast interests may have grown up under the practice and under judicial decisions which may be disturbed or destroyed by the announcement of a different rule."

It will therefore be assumed that an abandoned application is not an anticipation.

II.

In order to sustain the rule in the Lemley case, it is necessary to find a distinction between a disclosure of subject-matter in a patent and a disclosure in an abandoned application, which will justify assigning to the patent its date of filing instead of its date of grant.

Where the patent claims the subject-matter under consideration, a distinction is at once apparent. No one questions the correctness of the conclusion in the Sundh case, or that a patent speaks from its date of filing as to

all matter claimed therein. Otherwise it would be impossible to enforce the rule against double patenting. But subject-matter disclosed in a patent and not claimed therein is no more patented than it is in an abandoned application.

Westinghouse E. & M. Co. vs. *Stanley Inst. Co.*, 138 F. R., 823.
G. E. Co. vs. *Alexander*, 280 F. R., 852.

III.

Judge Denison in the Lemley opinion says that under R. S., Section 4920, a patentee must be the first inventor and that the second of two applicants cannot fulfill this condition. This statement makes no distinction between a disclosure in a patent and a disclosure in an abandoned application. Moreover, it fails to distinguish between the popular and the statutory use of the term "first inventor."

Automatic Weighing Machine Co. vs. *Pneumatic Scale Corporation*, 166 F. R., 288, 290;
Bullock vs. *Jones*, Federal Cases No. 2132;
Northwestern Fire Ex. Co. vs. *Phila. F. E. Co.*, Fed. Cases No. 10,337, pages 397-8.

An historical statement will be helpful in elucidating the point here under discussion.

Under the English law beginning with the Statute of Monopolies, 21 Jac. 1, V., patents might be granted for "the sole working or making of any manner of new manufacture within this realm to the first and true inventor or inventors of such manufactures which others at the time of making such letters patent and grants did not use, so they be not contrary", etc. This was the law of England at the time of the Revolution and when we

established our Federal patent system. Under this statute, the "inventor" might be an importer.

Edgeberry vs. *Stephens*, 2 Salkeld 446.

This recognition of the right to import an invention and patent it has never obtained here, or certainly not since the act of 1800.

Thompson vs. *Haight*, Federal Cases No. 13957, 23 F. C. 1040, 1044.

The Act of 1790, Section 6, makes the patent "*prima facie* evidence that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers, of the things so specified." The language was afterward changed to "original and first inventor" (R. S., 4920); but this new phrase does not seem to convey any special meaning different from "first and true inventor".

The Act of 1793, Sec. 6, recited as one of the defenses "that the thing thus secured by patent was not originally discovered by the patentee, or had been used or had been described in some published work anterior to the supposed discovery of the patentee." This added condition necessarily gave to the words "first and true inventor" a different meaning from what they had in the British act.

There was another distinction, since abolished. For the British statute only required that the manufacture should be new within the realm, whereas the acts both of 1790 and 1793 required that the improvement be not before known or used without regard to whether here or abroad.

These differences in meaning, however, are in no way based upon the phrase "first and true inventor" but rest upon statutory provisions which determine who may be an inventor. It seems clear therefore that the words

"first and true inventor" are fully accounted for in our statute as coming from the British Statute of Monopolies without carrying any meaning that requires a definition of inventor other than what may be derived from a reading of the statute itself.

It will not be necessary to review the reasoning of Judge Denison in detail. The following is presented as a construction of the statute which, if accepted by this Court, will lead to a conclusion at variance with the Lemley decision.

IV.

A general comment on Sections 4886 and 4920 will be of assistance in the presentation of this argument.

The two sections, R. S., Sec. 4886 and R. S., Sec. 4920, are respectively the granting clause and the defense clause of the statute. One should not be inconsistent with the other; but they are not necessarily co-extensive because defenses need not be recited in the statute. Any limitation indicated in the granting clause may be the foundation of a defense.

> *Pennock and Sellers* vs. *Dialogue,* 2 Peters, 1, 22-23.

Moreover, there are defenses not indicated in the statute which are founded upon the fundamental theory of the system.

> *Macbeth-Evans Glass Co.* vs. *General Electric Co.,* 246 F. R., 695.

Equally fundamental with that set up in the *Macbeth* case, is the defense that there are two patents for the same invention. Yet in the case of the *Barnes Sprinkler Co.,* though it is clear that the two patents under consideration were for the same invention, the Court seemed

to think it necessary to find statutory authority for this defense. Unless precluded by the form of the pleadings, the Court should have said merely that, since the Government had granted two patents for the same invention, in the absence of parol evidence the one of later filing date must be declared void. This has been held universally where two patents for the same invention have been granted to the same inventor. There is no specific statutory basis for this phase of the defense of double patenting and none is needed where there are two grantees.

Only a part of the language of Section 4886 concerns us. The invention or discovery is to be new and useful, not known or used by others in this country and not patented or described in a printed publication in this or any foreign country before applicant's invention or discovery thereof.

Every word has a definite purpose. It is as if the statute had said: The invention must be new, by which is meant that it was not known or used by others in this country, and that it had not been patented or described in a printed publication in any country at the date of the alleged invention.

"Known" means known in a physical sense as distinguished from knowledge conveyed through the printed page or by word of mouth.

> *Coffin* vs. *Ogden*, 85 U. S., 120;
> *Westinghouse* vs. *General Elec. Co.*, 207 F. R., 75.

If known be taken to be known in a physical sense, it imports into our statute the old English law of anticipation. Our addition to that law, i. e. making a publication and anticipation is added by a later clause.

This limited meaning is, it is believed, imposed by the language of Section 4886. For otherwise, to say "not known * * * or described in a printed publication" would be mere tautology.

Finally, there is nothing tautologous in the phrase "not known or used." It is true that *used* embraces everything that *known* expresses. But known is required to cover cases where the prior device, though capable of being used, was never actually used.

The clause of Sec. 4886 "unless the same is proved to have been abandoned" requires a word of discussion because of the strange meaning assigned to it in the brief filed *amicus* by the Government. Plainly these words do not refer back to anticipatory matter or to the two-year bars. They mean that one who is otherwise entitled to a patent may have lost his rights by abandonment of the invention to the public.

By the construction here suggested every part of the section is fully accounted for. So construed, the granting clause declares that anyone who has made an invention and takes proceedings in due time may obtain a patent for it if it is not already known in a physical sense in this country and if no one anywhere has secured a patent upon it or disclosed it in a printed publication. There is no more warrant in this section for setting up as a defense a patent application or a patent as of its date of application than there is for setting up the manuscript of an article as of the date when it was written or reached the editor of the publication in which it subsequently appeared. Either may be relied upon to establish a right to a patent or to sustain one of two or more rival patents; but in such cases only private rights are concerned. The general public must find support for such a defense elsewhere than in Section 4886.

Turning now to Section 4920, the first defense is merely to enforce frank disclosure. The third and fifth defenses are based on the language of Section 4886 respecting patents and printed publications, public use or sale of more than two years, and abandonment. The second and fourth defenses alone require discussion.

Rightly construed, the language in which these two defenses are set forth excludes the case of one who has obtained a patent for what is shown but not claimed in a patent granted upon a co-pending application.

Take the second defense. Such a claimant has done nothing surreptitious. He has proceeded openly under Sections 4886 and 4888 to 4893 of the Revised Statutes. Nor can it be said that the party who filed earlier was using reasonable diligence in adapting and perfecting his invention; all he has done is to show it incidentally in an application wherein he has sought to patent something else. The plain words of this defense must be strained to cover the case under discussion. And to what end? Merely to destroy the right of a man who thought enough of the invention to seek a patent upon it and pay the necessary fees, presumably with the intent of exploiting the invention.

The fourth defense covers priority, prior public use and a state of the art which leaves nothing material and substantial in what the patentee claims as an invention.

V.

Among those seeking patents, priority in time assures superiority of right. This is specifically provided in R. S., Sec. 4904, and the same rule obviously holds among rival patentees proceeding under R. S., Sec. 4918. If to this be added that there may be only one patentee of a single invention, it follows that anyone of the general public sued by one of two rival patentees may set up the prior right of one patentee against the patent of the other. But patentees are claimants. If there is no claim to common subject-matter there is not presented a case of rival patentees or conflicting or interfering patents.

Herein lies the basis of the distinction between anticipation and priority as defenses, which Judge Denison says he fails to understand. *Anticipation* is failure of

consideration for the patent. The public is already in possession of the invention which the patent purports to disclose to the public. The sufficiency of this defense in no way depends on whether or not the invention is claimed by some one other than the patentee suing or not. *Priority,* as a defense, is essentially a question of double patenting; and to the sufficiency of this defense the existence of two patents claiming the same invention is an essential condition.

To sum up the argument as to the meaning of the language of the statute, there is nothing found either in the granting clause (Section 4886), or in the defense clause (Section 4920), which requires the Court to give effect from its date of filing to a patent set up in defense respecting subject-matter disclosed but not claimed therein. To base such a holding on the second defense is to strain the language thereof and to base it on the fourth defense is to overlook the distinction between the "first inventor" in popular sense, and the "first inventor" according to a definition which is in conformity with the granting clause of the statute.

The only ground on which the court is warranted in assigning to a patent set up in defense its date of filing is that a case is presented of double patenting. In such a case the patent that is prior in date of filing is superior, in the absence of parol proof, and defeats the later patent. No statutory provision for this defense is necessary because, as a matter of fundamental principle, there can be only one patent for a single invention.

The construction adopted in the instant case and in *Farmers' Handy Wagon Co.* vs. *Beaver,* and here contended for, is not only in better accord with the statute than the construction adopted in the *Lemley* case; it is also in better conformity with the general policy of the courts respecting patents.

VI.

The primary purpose of the patent system is to advance the useful arts. This means that new implements of business or pleasure are to be put into the hands of the public. It has been demonstrated by experience that the patent system supplies an excellent method of effecting this desired end.

The public is not vitally interested in *knowing about* new things. What it demands is that it shall *have* the new things. Some one must take the risk and bear the burden of adaptation and introduction of inventions to meet the need. If a man has obtained a patent, he has contributed something toward the introduction of the thing patented. On the other hand, what is disclosed in a patent, without claiming it, is ordinarily not advanced materially toward becoming an implement in the hands of the people.

Suppose, for example, that Bell had described his telephone in a patent devoted to some new implement for teaching the deaf to speak. The public would have knowledge of the magnetic telephone; but the patent would have held out no inducement to undertake the vast expense and labor required before the telephone became an implement of household use.

If it were not true that the real public interest lies in having things that may be used rather than in having knowledge of inventions, and that the granting of patents on the whole operates to secure the introduction of new things, it would be impossible long to maintain the patent system. Yet it has been maintained and has so far commended itself to public opinion that patents have always been liberally treated by the courts.

To take one example, it is frequently said that doubt as to the presence of invention should be resolved in favor of the inventor. Unless applied with judgment, this rule would lead to the approval of the frivolous or trivial. But there is no difficulty about interpreting the

statute in a liberal spirit and resolving doubt in favor of the inventor.

There is here presented a question of construction where, without any straining of the language of the statute or of any of the principles established in the great cases which illuminate our law of patents, the doubt, if there be any, may be resolved in favor of the patentee.

The question raised in this case does not arise in numerous cases. It is however of great importance because the authoritative construction of the statute must necessarily have a direct bearing and may have a controlling bearing on the effect on the validity of patents of private memoranda, secret uses, manuscripts awaiting publication, and abandoned applications. With reference to the last alone, it may be stated that there are in the Patent Office over a million abandoned applications, twenty-five per cent. of which were first allowed and then forfeited and abandoned, indicating a disclosure therein that was deemed by the examiner to include patentable subject-matter. These applications are not in convenient form for examination and are classified according to a scheme which is rendered archaic by the lapse of time. If for any reason this court should reverse its decision in the *Cornplanter* case and hold these abandoned applications available as references, they would bring down on the art a mass of anticipatory material which would vastly increase the uncertainty, already large enough, as to the validity of any patent.

The rule of the *Farmers' Handy Wagon* case and the instant case that a patent set up as a defense speaks only from the date of its grant as to all matter disclosed but not claimed therein, is in conformity with the letter and spirit of the statute and should be approved and applied in appropriate cases.

Respectfully submitted,

THOMAS EWING
As *Amicus Curiae.*

APPENDIX.

Patent Act of 1790.

SECTION 1. Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That upon the petition of any person or persons to the Secretary of State, the Secretary for the Department of War, and the Attorney-General of the United States, setting forth that he, she, or they hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, or shall and may be lawful to and for the said Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters-patent to be made out in the name of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters-patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that pur-

pose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent by the said Secretary at the time of granting the same.

SECTION 6. And be it further enacted, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers, of the things so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

Patent Act of 1793.

Section 1. Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine,

manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

Section 6. Provided, always, and be it further enacted, That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole

truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

21 Jac. I, cap. 3. An Act concerning Monopolies and Dispensations with penal laws and the forfeitures thereof.

VI. Provided also, and be it declared and enacted that any declaration before mentioned shall not extend to any letters patents and grants of privileges for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient, the said fourteen years to be accounted from the date of the first letters patents or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made and of none other.